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| 09/998,421                       | 11/29/2001  | Thomas E. Macken JR. | G07.003             | 5928             |
| 28062                            | 7590        | 11/20/2006           | EXAMINER            |                  |
| BUCKLEY, MASCHOFF, TALWALKAR LLC |             |                      | SWARTZ, JAMIE H     |                  |
| 50 LOCUST AVENUE                 |             |                      | ART UNIT            |                  |
| NEW CANAAN, CT 06840             |             |                      | PAPER NUMBER        |                  |
|                                  |             |                      | 3694                |                  |

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/998,421

Applicant(s)

MACKEN ET AL.

Examiner

Jamie H. Swartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3-7 and 11-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 8-10, and 22-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372. This application contains claims directed to the following patentably distinct species:

- I. Claims 1, 2, 8-10, 22, and 23, disclose determining costs, revenues, a transaction processing function, a business integration function, an accounting function, and a reporting function, classified in class 705, subclass 30.
- II. Claims 1, 3, 4, 8-10, 22, and 23, disclose determining and receiving data indicative of an EFT score, classified in class 705, subclass 9.
- III. Claims 1, 5, 8-10, 22, and 23, disclose identifying an area of a process that involves transaction processing of data and reconciliation of an account, classified in class 705, subclass 39.
- IV. Claims 1, 6, 7, 8-10, 22, and 23, disclose receiving an EFT score associated with a rework and a manual process and then identifying a process involving rework and a process involving manual entry of data, classified in class 705, subclass 11.
- V. Claims 11, 12, 14-16, 20, and 21, disclose determining an EFT score associated with a manual aspect of a process, classified in class 705, subclass 8.

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VI. Claims 11, 13, 14, 17, 18, 20, and 21, disclose determining an EFT score associated with a rework aspect of a process, classified in class 705, subclass 1.

VII. Claims 11, and 19-21, discloses determining a core competency associated with a process after determining an EFT score, classified in class 705, subclass 11.

2. The species are independent or distinct because of the following reasons:

Species I has a separate utility such as determining costs, revenues, a transaction processing function, a business integration function, an accounting function, and a reporting function. Species I does not require the distinct features of species II-VII.

Species II has a separate utility such as determining and receiving data indicative of an EFT score. An EFT score deals with the people that perform tasks. Species II does not require the distinct features of species I and III-VII.

Species III has a separate utility such as identifying an area of a process that involves transaction processing of data and reconciliation of an account. Species III does not require the distinct features of species I-II and IV-VII.

Species IV has a separate utility such as receiving an EFT score associated with a rework and a manual process and then identifying a process involving rework and a process involving manual entry of data. Species IV does not require the distinct features of species I-III and V-VII.

Species V has a separate utility such as determining an EFT score associated with a manual aspect of a process. Species V does not require the distinct features of species I-IV and VI-VII.

Species VI has a separate utility such as determining an EFT score associated with a rework aspect of a process. Species VI does not require the distinct features of species I-V and VI-VII.

Species VII has a separate utility such as determining a core competency associated with a process after determining an EFT score. Species VII does not require the distinct features of species I-VI.

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

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4. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

5. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

6. During a telephone conversation with Randolph Calhoun (45371) on November 3, 2006 a provisional election was made without traverse to prosecute Species I, Claims 1, 2, 8-10, 22, and 23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-7 and 11-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Regarding claim 1, the phrase "identifying a process for revision" is vague and renders the claim indefinite because the term "process" is too broad since it is recited without any context and any degree of specificity that would allow the examiner to perform claim analysis within a specified field of endeavor. The term "process" being vague and indefinite also leads to the entire claim to be indefinite since all other limitations are dependent on it. The phrase "determining at least one value added aspect" is vague and renders the claim indefinite because the criteria for an aspect to be a value added aspect is too broad. Within the scope of the claim it is unknown what makes an aspect value added and who will identify the aspect as such. The term "desired revision" to said process is vague and unclear. Since, a desired act is purely speculative, subjective and without specific standard or rules and therefore indefinite.

10. While the foregoing analysis is applicable to claim 1, the applicant should note that similar deficiencies are present in all dependent and independent claims. The applicant should review all claims and correct the deficiencies as appropriate.

11. Regarding claim 2, the phrase "determining costs associated with a plurality of processes and selecting the process from the plurality that has the highest associated cost" is vague and renders the claim indefinite. It is unknown if the costs contain cost of labor, supplies, or equipment. The phrase "determining revenues associated with a plurality of processes and selecting the process from the plurality of process that has the lowest associated revenue" is vague and renders the claim indefinite because the criteria or algorithm for calculating the revenue is not taught. It is unknown if the revenue is calculated using sales, rendering of services, and earnings from interest, dividends, lease income, and royalties or a combination thereof. The phrase "determining at least one transaction processing function associated with a specific business need" is vague and renders the claim indefinite because the elements of a transaction processing function are not disclosed. It is unclear how a transaction integration function is defined within this context and how it is determined. The phrase "determining at least one business integration function associated with a specific business need" is vague and renders the claim indefinite because the elements of a business integration function are not disclosed. It is unclear what is being integrated and how it is being integrated. The phrase "determining at least one accounting function associated with a specific business need" is vague and renders the claim indefinite



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because the elements of an accounting function are not disclosed. Claiming a general accounting function, as there are well over a hundred accounting functions, renders the scope of the claim unascertainable.

***Claim Rejections - 35 USC § 101***

12. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

13. To be useful the invention must be useful, concrete, and tangible. An invention is useful when it is specific. Because the claim language is indefinite it is not specific enough to allow one of ordinary skill in the art to produce a result that reflects itself to be a useful result.

14. Claim 1 has been discussed (or analyzed) as an exemplary claim. The analysis also applies to all other claims.

15. An invention is concrete when a result can be assured or is reproducible. Since the invention as it stands in the claims is indefinite with undefined elements, revision of a process as described in the claims does not result in a concrete result. Identifying a process and determining functions of a process are broadly interpreted as manual

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actions, involving subjective decision-making. When manual actions are involved in a process the outcome cannot be consistently reproducible, therefore lacking a concrete result. Based upon this analysis it is concluded that the claimed invention(s) do not reproduce a concrete result.

16. An invention is tangible when it has a real world result. When an invention is not concrete it is abstract and when an invention is abstract it does not produce a useful result. Taking undefined processes and undefined steps leads to something that isn't tangible, because the claimed invention cannot be relied upon to practice any real world application. Based upon this analysis, the examiner asserts that the claimed invention does not set forth a practical application, since it does not produce a concrete and tangible result and therefore is rejected under 35 USC § 101.

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

18. Claims 1, 8, 9, 10 are rejected under 35 U.S.C. 102(a) as being anticipated by Curtis et al., "People Capability Maturity Model (PCMM)," July 2001 (hereafter referred to as Curtis) (Article may be accessed on Google by key words "People Capability

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Maturity Model" the examiner has only provided specifically referenced pages). PCMM is defined by wikipedia.com to be *a maturity framework that focuses on continuously improving the management and development of the human assets of an organization*. PCMM discloses a *process for revision* that helps organizations to successfully address their critical people issues. PCMM evaluates fields such as *human resources, knowledge management, and organizational development, and guides organizations in improving their processes for managing and developing their workforces*. PCMM discloses quantitative performance management that is applied to individuals and workgroups. The steps involve identifying *competency-based processes* (pg. 479). Curtis discloses the next step that involves locating the *value added* step to determine which *competency-based process most contributes to the achievement of the unit's measurable performance objectives* (pg. 479). Curtis also discloses a form of revision by establishing *measurable objectives for the performance of the selected competency-based processes to ensure that the unit's measurable objectives are achieved* (pg. 479).

19. Regarding claims 8-10 the Curtis also discloses that a *strategic workforce plan includes a risk assessment of the organization's ability to attract, recruit, and retain the workforce that will be needed for conducting its future business. The strategic workforce plan is reviewed and revised periodically to reflect changes in the business. The strategic workforce plan is intended to provide a relatively stable set of workforce objectives for the organization to pursue. Revisions to the plan most likely occur as*

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*revisions to competency development plans are made. Revisions to the strategic workforce plan typically only occur in the presence of changes in business conditions or technologies.* (pg. 280). Referring to claim 8 and 9, Curtis discloses how PCMM revises a process the process is then implemented. Referring to claim 10, Curtis discloses how PCMM takes the process which is then reviewed or evaluated.

### ***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis as discussed in the claim 1 rejection and further view of (a) admitted prior art and (b) officially taken notice.

a. Curtis does disclose the revision of a process discussed in claim 1. Curtis in view of admitted prior art fails to teach the determination of costs and revenues as stated in claim 2. It is stated in the specification that *a company's annual reports, accounting, etc. may reveal the costs and benefits associated with*

*certain functions or other processes conducted by the company. A process may be determined during the step 202 by selecting a process for revision that generates a high cost and/or low return. Such costs may be measured in labor costs, capital costs, etc. (§ 40)* It is well known to look at a company's annual reports or accounting data to determine costs and revenue associated with the process of doing business. It would have been obvious to a person of ordinary skill in the art at the time of the invention to get revenue and cost data for a processes used by an organization from the company's accounting information or annual reports.

b. Curtis does disclose the revision of a process discussed in claim 1. Curtis in view of official notice fails to discuss the functions as stated in claim 2. Official notice is taken that the processes of determining one transaction processing, one business integration, one accounting, and one reporting function was old and well-known in processing financial transactions as a customary business practice at the time of the invention. Each of these four aspects of a process could be seen at any customer service establishment associated with the business need to achieve efficiency. A transaction occurs when ordering, business integration includes customer service, accounting occurs with the balancing of drawers at the end of the day, and reporting includes financial reports. It would have been obvious to a person of ordinary skill in the art at the time of the invention to

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include those four aspects of a process in any day-to-day customer service business as a matter of customary business practice.

22. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis. Curtis does not specifically disclose the use of a computer to carry out a process revision. Curtis does disclose all the functions associated with claim 22 and 23 as discussed previously in the claim 1 rejection. It would have been obvious to one of ordinary skill in the art at the time of invention to use a computer to increase the efficiency and accuracy of the program as well as capitalizing on the basic functions of a computer such as calculating, comparing, copying, and storage. It would also have been obvious to one of ordinary skill in the art at the time of invention to add instructions or steps to the process, as a process by definition is a series of actions, changes, or functions bringing about a result. It was known at the time of the invention that merely providing an automatic means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie H. Swartz whose telephone number is (571) 272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jamie Swartz  
November 6, 2006

  
  
**JAGDISH N. PATEL**  
**PRIMARY EXAMINER**